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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,710	10/08/1999	SCOTT FABER	9997-003	3759

7590

10/03/2002

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

36

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,710

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109-136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 109-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2002 has been entered. As per Applicant's request, the After-Final amendment filed on August 26, 2002 has been entered.

Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 have been cancelled.

Claims 109-136 have been added.

Claims 109-136 are presented for examination.

2. All previously pending rejections are withdrawn in light of Applicant's cancellation of all previously pending claims. New rejections, addressing newly added claims 109-136, follow. (Applicant's arguments are directed to the newly added claims, which will be addressed in the new art rejection found below.)

Specification

3. The abstract of the disclosure is objected to because it does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 109-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer (U.S. Patent No. 6,223,165 B1).

Lauffer discloses a method of connecting two parties in real time, the method comprising:

[Claim 109] displaying a list of service providers to a customer via an internet connection with the customer prior to the customer submitting a question (claim 1);

the list indicating individually whether each service provider in the list of service providers is currently available to telephonically communicate with the customer at a time when the customer is viewing the list (claim 1);

receiving a customer selection of a displayed icon corresponding to a service provider from the list (claim 1); and

a controller computer using the selection from the customer to initiate a process of establishing a telephonic connection between the service provider and the customer prior to the customer submitting a question to the service provider (claim 1);

the process of establishing the telephonic connection further includes the controller computer placing a telephone call to the service provider, and the controller computer placing a telephone call to customer (claim 1);

[Claim 110] after establishing the telephonic connection between the service provider and the customer, changing the indication of the current availability status for the service provider (col. 6, lines 30-33; claim 3 – The expert's, i.e., service provider's, availability status is presumably updated with every change in status);

[Claim 111] after the telephone connection has ended, prompting the customer to evaluate the service provider (claim 2);

[Claim 112] wherein the list is provided in response to a category selection (col. 5, lines 3-7; col. 9, lines 32-35);

[Claim 113] wherein the service provider and the customer each have a telephone number, and the telephonic connection is established without disclosing the telephone number of the service provider to the customer and without disclosing the telephone number of the customer to the service provider (col. 9, lines 15-21);

[Claim 114] tracking how long the telephonic connection is maintained between the service provider and the customer (claim 13); and

billing the customer based upon how long the telephonic connection is maintained (claim 14);

[Claim 115] before providing the list, setting up an account for the service provider (claim 15); and

crediting the account for an amount based upon how long the telephonic connection is maintained (claim 15);

[Claim 116] before providing the list, setting up a customer account for the customer (claim 17);

[Claim 118] tracking how long the telephonic connection is maintained between the service provider and the customer (claim 19); and

deducting from the customer account an amount based upon how long the telephonic connection is maintained (claim 19).

Regarding claim 109, Lauffer allows a customer to request a telephonic connection with an expert (claim 1), yet Lauffer does not explicitly teach, upon establishing the telephonic connection, the subsequent prompting of the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list. However, Official Notice is taken that it is old and well-known in the art of Internet/telephonic connections to allow a user to verify a desire to connect to or disconnect from another party. For example, Internet users are often provided with the options of connecting, disconnecting, canceling a request, etc. These options are standard in the art and they allow a user to prevent or cancel undesired connections or to even abort an existing connection that is simply no longer needed (thereby conserving system resources). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with Lauffer the step of subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list, upon establishing the telephonic connection, in order to provide a user with the convenience of preventing or canceling undesired connections or even aborting an existing connection that is simply no longer needed (thereby conserving system resources).

As per claim 117, Lauffer discloses the step of tracking how long the telephonic connection is maintained between the service provider and the customer (claim 19), yet he fails to explicitly teach the step of notifying the customer in real time of a balance in the customer account while the telephonic connection is being maintained. Lauffer does however discuss the use of credit card, cyber money, phone, or media accounts to make payment (col. 8, lines 27-29, 41). Further, Official Notice is taken that it is old and well-known in the art of service providing to refuse service to someone if that person does not have the means to pay for such a service. For example, if one's credit card is denied, service will be refused. If there is insufficient balance on a cyber money account (i.e., a prepaid user account), service is typically denied. Again, a phone call cannot be completed if the phone card used to make the call is lacking funds. Additionally, a phone call may be cut off in mid-conversation if one's funds run out. This is even analogous to the common scene in movies where the operator cuts in on an important call to announce, "Please deposit one dime." These practices protect the respective service providers from not getting paid after providing a service. Consequently, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to interrupt a connection and request that the user of Lauffer's system add money to his/her account in response to the prepaid user account falling below a predetermined threshold (i.e., "while the telephonic connection is being maintained, notifying the customer in real time of a balance in the customer account") in order to ensure that information/service providers will adequately and timely be paid for services rendered.

*This is not a
"business"
in real time*

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[Claims 119-127] Claims 119-127 recite a computer system with limitations already addressed by the rejection of claims 109-118 above; therefore, the same rejection applies. Lauffer incorporates all of the structural elements recited in claims 119-127, including a database, server, computer, etc. (e.g., see claims 20-34 of Lauffer).

[Claims 128-136] Claims 128-136 recite an article of manufacture with limitations already addressed by the rejection of claims 109-118 above; therefore, the same rejection applies. Lauffer incorporates a computer-readable medium (e.g., see claims 35-43 of Lauffer).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 109-136 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,223,165 B1 in view of Official Notice, as discussed in the art rejection above.

8. Claims 109-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-147 of copending Application No. 09/733,872 in view of Official Notice. Please note that Application No. 09/733,872 is a Continuation of U.S. Patent No. 6,223,165 B1 and the claims in both Application No. 09/733,872 and U.S. Patent No. 6,223,165 B1 are substantially similar; therefore, the same Double Patenting analysis applied to U.S. Patent No. 6,223,165 B1 and the present application applies to Application No. 09/733,872 as well.

This is a provisional obviousness-type double patenting rejection.

9. Claims 109-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-141 of copending Application No. 09/782,925 in view of Official Notice. Please note that Application No. 09/782,925 is a Continuation of U.S. Patent No. 6,223,165 B1 and the claims in both Application No. 09/782,925 and U.S. Patent No. 6,223,165 B1 are substantially similar; therefore, the same Double Patenting analysis applied to U.S. Patent No. 6,223,165 B1 and the present application applies to Application No. 09/782,925 as well.

This is a provisional obviousness-type double patenting rejection.

10. Claims 109-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-137 of

copending Application No. 09/782,984 in view of Official Notice.. Please note that Application No. 09/782,984 is a Continuation of U.S. Patent No. 6,223,165 B1 and the claims in both Application No. 09/782,984 and U.S. Patent No. 6,223,165 B1 are substantially similar; therefore, the same Double Patenting analysis applied to U.S. Patent No. 6,223,165 B1 and the present application applies to Application No. 09/782,984 as well.

This is a provisional obviousness-type double patenting rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687

[Official communications; including
After Final communications labeled
"Box AF"]

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(703)746-7048

[Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Patent Examiner
Art Unit 3623
October 1, 2002